

ESTTA Tracking number: **ESTTA723505**

Filing date: **01/28/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91200832
Party	Plaintiff Briggs & Stratton Corporation and Kohler Co.
Correspondence Address	ROBERT N PHILLIPS REED SMITH LLP 101 SECOND ST, STE 1800 SAN FRANCISCO, CA 94105 UNITED STATES ipdocket-chi@reedsmith.com, nborders@reedsmith.com, robphil- lips@reedsmith.com, knowakowski@whdlaw.com, dkalahele@rddsmith.com, ebridge@whdlaw.com, mgi
Submission	Rebuttal Brief
Filer's Name	Robert N. Phillips
Filer's e-mail	robphillips@reedsmith.com, sherring@reedsmith.com, dkala- hele@reedsmith.com
Signature	/s/ Robert N. Phillips
Date	01/28/2016
Attachments	Opposers Briggs & Stratton Corporation's and Kohler Co.'s Reply Trial Brief (Redacted Version).pdf(1388057 bytes)

BRIGGS & STRATTON CORPORATION

Opposer,

VS.

HONDA GIKEN KOGYO KABUSHIKI KAISHA,

Applicant.

Opposition No. 91200832 (Parent)

KOHLER CO.

Opposer,

VS.

HONDA GIKEN KOGYO KABUSHIKI KAISHA,

Applicant.

Opposition No. 91200146

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

**OPPOSERS BRIGGS & STRATTON CORPORATION'S
AND KOHLER CO.'S REPLY TRIAL BRIEF**

Respectfully submitted on January 28, 2015,

/s/ Robert N. Phillips
Robert N. Phillips
Seth B. Herring
Reed Smith LLP
101 Second Street
San Francisco, CA 94105
*Attorneys for Opposer Briggs &
Stratton Corporation*

/s/ Kenneth R. Nowakowski
Kenneth R. Nowakowski
Melinda Giftos
Whyte Hirschboeck Dudek S.C.
535 East Wells Street, Suite 1900
Milwaukee, WI 53202
Attorneys for Opposer Kohler Co.

TABLE OF CONTENTS

Item	Page
Table of Authorities	3
Introduction.....	4
I. The Applied-For Mark is Functional.....	4
A. Honda’s Proposed Mark is Defined in the Application.....	5
B. Honda’s Applied-For Mark is <i>De Jure</i> Functional.....	7
1. Honda’s Overall Design & Location of Component Parts is Functional.....	7
2. The Only Features Honda Does Not Admit to Be Functional Are Insufficient to Render the Overall Function Design Non- Functional.....	9
3. Courts Have Rejected the Semantic Trickery Honda is Asserting in this Case.....	10
4. Honda’s Fundamental Misapplication of Trade Dress Law Has Infected Its Application of the Four Morton Norwich Factors....	11
5. Honda Has Not Consistently Defined its Trademark.....	13
II. The Applied-For Mark Lacks Secondary Meaning.....	14
A. The Length of Honda’s Use is Irrelevant Because it is Non-Exclusive.....	15
B. Honda’s Advertising and Sales Merely Show that the GX is Successful.....	16
C. Honda’s Distributor Statements are Irrelevant to Secondary Meaning.....	18
D. Honda’s Evidence of Alleged “Copying” Does Not Support Secondary Meaning	19
E. The Survey Evidence Strongly Supports the Lack of Secondary Meaning.....	20
1. Honda Concedes the Fatal Flaws in Mr. Mantis’s Survey.....	20
2. Mr. Mantis’s Survey Did Not Test for Secondary Meaning in the Allegedly Non-Functional “Complimentary Lines, Angles and Beveling”.....	21
3. Honda’s Critiques Regarding Mr. Poret’s Survey are Immaterial and Inaccurate.....	22
III. The Applied-For Mark Is Generic.....	23
IV. Honda Has Abandoned The Applied-For Mark.....	24
CONCLUSION.....	25
Appendix A.....	A-1
Appendix B.....	A-10

TABLE OF AUTHORITIES

CASES	Page(s)
<i>Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.</i> , 107 U.S.P.Q.2d 1750 (T.T.A.B. 2013)	20
<i>AS Holdings, Inc. v. H.&C. Milcor, Inc.</i> , 107 U.S.P.Q.2d 1829 (T.T.A.B. 2013)	18
<i>George Basch Co. v. Blue Coral, Inc.</i> , 968 F.2d 1532, 23 U.S.P.Q.2d 1351 (2d Cir. 1992)	16
<i>In re Becton, Dickinson, & Co.</i> , 675 F.3d 1368, 102 U.S.P.Q.2d 1372 (Fed. Cir. 2012)	5, 7, 10, 12, 13
<i>In re Black & Decker Corp.</i> , 81 U.S.P.Q.2d 1841 (T.T.A.B. 2006)	17
<i>In re Bose Corp.</i> , 476 F.3d 1331, 81 U.S.P.Q.2d 1748 (Fed. Cir. 2007)	5, 6, 7
<i>In re Boston Beer Co. Ltd. P'ship.</i> , 198 F.3d 1370, 53 U.S.P.Q.2d 1056 (Fed. Cir. 1999)	16
<i>In re Charles N. Van Valkenburgh</i> , 97 U.S.P.Q.2d 1757 (T.T.A.B. 2011)	20
<i>In re CTB, Inc.</i> , 52 U.S.P.Q.2d 1471 (T.T.A.B. 1999)	25
<i>In re Florists' Transworld Delivery, Inc.</i> , 106 U.S.P.Q.2d 1784 (T.T.A.B. 2013)	19
<i>In re Heatcon, Inc.</i> , 166 U.S.P.Q.2d 1366 (T.T.A.B. 2015)	6
<i>In re Pacer Technology</i> , 338 F.3d 1348 (Fed. Cir. 2003)	19
<i>In re Pohl-Boskamp GmbH & Co.</i> , 106 U.S.P.Q.2d 1042 (T.T.A.B. 2013)	19
<i>Kistner Concrete Prods., Inc. v. Contech Arch Technologies, Inc.</i> , 97 U.S.P.Q.2d 1912 (T.T.A.B. 2011)	5, 13
<i>L.A. Gear, Inc. v. Thom McAn Shoe Co.</i> , 12 U.S.P.Q.2d 1001 (S.D.N.Y. 1989) aff'd	16
<i>Nabisco Inc. v. Wm. Wrigley Jr. Co.</i> , 40 U.S.P.Q.2d 1251 (T.T.A.B. 1995)	24
<i>Parfums Nautee Ltd. v. Am. Int'l Indus.</i> , 22 U.S.P.Q.2d 1306 (T.T.A.B. 1992)	24
<i>Secalt, S.A., v. Wuxi Shenxi Constr. Mach. Co.</i> 668 F.3d 677, U.S.P.Q.2d 1553 (9 th Cir. 2012)	10, 11
<i>Straumann Co. v. Lifecore Biomedical Inc.</i> , 278 F. Supp. 2d 130 (D. Mass. 2003)	21
<i>Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.</i> , 94 U.S.P.Q.2d 1549 (T.T.A.B. 2009)	15, 16, 17, 20
<i>Thomas & Betts Corp. v. Panduit Corp.</i> , 65 F.3d 654, 36 U.S.P.Q.2d 1065 (7th Cir. 1995)	21
<i>TrafFix Devices, Inc. v. Mktg. Displays, Inc.</i> , 532 U.S. 23, 58 U.S.P.Q.2d 1001 (2001)	11, 12
<i>Valu Eng'g. Inc. v. Rexnord Corp.</i> 278 F.3d 1268, 1276, U.S.P.Q.2d 1422 (Fed. Cir. 2002)	12
<i>Yamaha Int'l. Corp. v. Hoshino Gakki Co.</i> , 840 F.2d 1572, 6 U.S.P.Q.2d 1001 (Fed. Cir. 1988)	17

INTRODUCTION

In an effort to avoid a finding of functionality, Honda strains to narrowly interpret its applied-for mark as simply consisting of certain “complementary” angles and lines. But, in a footnote, Honda reluctantly acknowledges that, of course, the engine’s cubic shape, and the configuration of the major component parts of the engine, are also part of the applied-for mark. The evidence overwhelmingly demonstrates that the engine’s cubic shape and configuration are significant features of the design and that they provide numerous functional advantages. Given that the utility of the applied for mark substantially outweighs the minor nonfunctional elements, the applied-for mark must be rejected as functional. In addition, there is widespread third-party use of the applied-for mark’s shape and configuration, and no evidence that Honda ever treated the engine appearance, aside from its colors, as a source-indicator. Thus, the applied-for mark has not achieved secondary meaning. If, somehow, the minor elements Honda identifies were sufficient to avoid a finding of functionality, and consumers associated those minor elements with only Honda, then Honda abandoned the applied-for mark by permanently changing those elements, with no intent to resume their use, when Honda redesigned the GX engine. For these reasons, registration of Honda’s applied-for mark must be refused.

I. HONDA’S APPLIED-FOR MARK IS FUNCTIONAL.

Honda’s applied-for mark is a text book example of a *de jure* functional product configuration. Numerous witnesses, including Honda’s corporate representative regarding functionality and expert witness on functionality, have admitted that the overall, compact and boxy shape of the applied-for product configuration is functional and is necessary to compete in the marketplace. (*See* Opposers Br., 31-32.) Similarly, there is ample testimony in the record that the locations of each of the major component parts of the engine depicted in the applied-for mark are dictated by utilitarian purposes and basic engineering requirements. (*See id.*, 15-17.) Finally, there is testimony in the record that demonstrates that many of the so-called design “embellishments” Honda claims to be arbitrary, such as seams, angles, straight lines, beveling and locations of control levers, serve utilitarian purposes, are cost effective and/or constitute ideal designs. (*See id.*, 6-17.)

In addition to this testimony, Opposers have introduced numerous utility patents and utility

models filed by Honda that claim, describe and/or depict the same features Honda seeks to protect now through trademark law. (*See id.*, 19-22.) Opposers have also presented evidence of extensive third-party use of the very same basic engine configuration over which Honda now seeks a monopoly. (*See id.*, 23-25.) In addition, Opposers have shown that Honda’s advertising has always touted the utilitarian advantages of its engine rather than any aesthetic or arbitrary aspect of the shape of the engine. (*See id.*, 25-27.) Taking all of this evidence together, Opposers have more than met their burden of establishing a *prima facie* case that the applied-for product configuration is functional.

Honda has not and cannot overcome this evidence, nor can it meet its heavy burden of demonstrating that its applied-for mark, as a whole, is arbitrary or *de jure* non-functional. To the contrary, Honda has attempted to avoid the overwhelming evidence of functionality by narrowly characterizing its applied-for mark. This is improper, as the mark consists of the totality of the drawing and description set forth in Honda's trademark application. Further, the “complementary lines, angles and beveling” that allegedly make up Honda’s so-called “cubic design” are nothing more than slants, lines and shapes that contribute to the compactness and other functional aspects of the engine. (Honda Br. 8-10.) The few flourishes that Honda identifies which could arguably be considered arbitrary, such as the four rib marks on the carburetor cover and the “belt-like area” on the air cleaner cover, are no longer used on Honda’s engines. (Opposers Br. 27-28.) Even if they were still used, however, it is well settled that minor flourishes such as those are insufficient to render an otherwise functional engine configuration protectable under trademark law. *See, e.g., In re Becton, Dickinson, & Co.*, 675 F.3d 1368, 1374, 102 U.S.P.Q.2d 1372 (Fed. Cir. 2012) (“a mark possessed of significant functional features should not qualify for trademark protection where insignificant elements of the design are non-functional.”); *Kistner Concrete Prods., Inc. v. Contech Arch Technologies, Inc.*, 97 U.S.P.Q.2d 1912, 1919 (T.T.A.B. 2011)(“Case law also makes clear that the inclusion of a nonfunctional feature does not make an otherwise functional configuration distinctive and therefor registrable.”); *See In re Bose Corp.*, 476 F.3d 1331, 81 U.S.P.Q.2d 1748 (Fed. Cir. 2007).

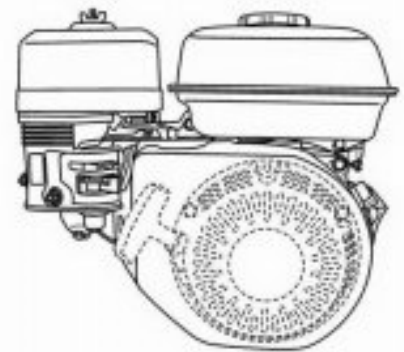
A. Honda’s Proposed Mark is Defined in the Application.

To determine whether the applied-for mark is functional, the Board must begin by identifying the

subject matter of Honda's trademark application. *See In re Heatcon, Inc.*, 166 U.S.P.Q.2d 1366, *5 (T.T.A.B. 2015). In an effort to avoid a finding of functionality, Honda claims that it is not asserting rights in the "basic configuration" of the engine and that its applied-for mark is "complementary lines, angles and beveling of each component that creates the distinct overall cubic look of the GX Trade Dress."¹ (Honda Br. 18-20.) This is inaccurate, however, and improperly infects all of the arguments in Honda's brief relating to functionality.

In analyzing whether the applied-for trademark is functional, the Board must view the mark as it is defined in the drawing and description set forth in Honda's trademark application:

The mark consists of the configuration of an engine with an overall cubic design, with a slanted fan cover, the fuel tank located above the fan cover on the right, and the air cleaner located to the left of the fuel tank. The air cleaner cover features a cube shape with beveled top outside edges, and a belt-like area on the lower portion of the cover encompassing the entire circumference and the top of the belt-like area is aligned with a rib of the fuel tank. The carburetor cover features four ribs along its outside edge and a recessed area where control levers are located. The fuel tank is roughly rectangular[.] The engine features a beveling that runs around its top circumference. The broken lining in the drawing is not part of the mark and serves only to indicate position.



See In re Becton 675 F.3d at 1371; *In re Bose Corp.*, 476 F.3d at 1336. The above drawing and description are not limited to complementary lines, angles and beveling. To the contrary, the application depicts and describes the overall configuration of the engine, including the particular locations of the main component parts (fuel tank, air cleaner cover, carburetor cover and fan cover), along with additional functional features, such as a slant in the fan cover, the "roughly rectangular" shape of the fuel tank, and the "cube shape" air cleaner cover. There is no mention of any "complementary" lines or angles in the description. If Honda intended to limit its application to the narrow definition proposed in its trial brief, Honda would have disclaimed the overall configuration of the engine and location of the major component parts (as it did with respect to the nuts, bolts and levers). Honda also would have crafted the description language to clearly limit the mark. Honda purposefully elected not to do either, however, and

¹ In a footnote in its trial brief, Honda also states that "the shape and position of the component parts is part of the GX Trade Dress," however, Honda appears to consistently claim that this is somehow limited by the "overall cubic look" and alleged "styling features of the component parts." (Honda Br. 8, n1.)

as it now stands, the overall configuration of the engine and location of the component parts remain claimed elements of Honda's applied-for trademark. The Board should therefore construe Honda's mark as set forth in the application, and should reject Honda's narrow, opposition-driven characterization advanced in its briefing. *See, e.g., In re Becton*, 675 F.3d at 1371 (noting that the T.T.A.B. rejected applicant's narrowed definition of its applied-for mark when the drawing contained additional matter); *In re Bose Corp.*, 476 F.3d at 1336 (noting that applicant's applied-for design was not limited to the specific elements applicant chose to focus upon but instead the entire design set forth in the application).

B. Honda's Applied-For Mark is *De Jure* Functional.

Honda claims that Opposers applied an incorrect construction of the applied-for mark and an incorrect legal standard in their functionality analysis. Specifically, Honda argues that because Opposers have claimed the overall engine configuration is functional, Opposers' argument is based on the position that Honda's applied-for mark is *de facto* functional rather than *de jure* functional. This is incorrect and is a mischaracterization of Opposers' argument.

De facto functionality "means that a design has a function." *In re Becton*, 675 F.3d at 1373. In this case, it is undisputed that Honda's general utility engine clearly has a *de facto* function: it powers equipment. Opposers acknowledge that such functionality is irrelevant to the question of whether the applied-for mark as a whole is ineligible for trademark protection. However, Opposers have demonstrated that the Honda GX engine is *de jure* functional: it is designed in a cubic and boxy shape because it works better in that shape. *See id.* at 1374 ("De jure functionality 'means that the product is in its particular shape because it works better in this shape.'"). It is well settled that "whenever a proposed mark includes both functional and non-functional features, as in this case, the critical question is the degree of utility present in the overall design" itself. *Id.* at 1373. Here, Honda's applied for engine design is comprised of significant functional features with only insignificant elements of the design that are non-functional. The degree of utility present in the overall design is substantial, and far outweighs the few, minor non-functional flourishes.

1. Honda's Overall Design & Location of Component Parts is Functional.

While Honda's definition of "overall cubic design" is very narrow in its trial brief, Honda's

expert on functionality and corporate designees all understood the mark to comprise the overall engine configuration, the location of component parts, as well as other elements identified in the application.² These same witnesses have admitted that the shape and configuration of the applied-for mark is functional. (Opposer Br. 36-38.) For example, Fujita acknowledged that Honda's goal in developing the GX engine was [REDACTED]

[REDACTED] Mieritz also conceded that the overall cubic design of the engine contributes to the compactness of the engine, enables easy maintenance, and allows the engine to fit within a wide variety of OEM applications. (Opposer Br. 31-32.) This testimony was echoed by several other witnesses who agreed that the size and shape of the GX engine was industry standard and was required to fit within OEM dimensions. (Opposer Br. 15-17.)

Mieritz and Fujita likewise conceded that each component part of the engine has a functional purpose, is placed in its relative location based on engineering and other functional requirements, and that certain elements described in Honda's application serve functional purposes, such as the slant of the fan cover, which has the purpose of directing cool air toward the hottest part of the engine. (Mieritz 211:12-23; Fujita 26:5-47:22.) Importantly, Mieritz also admitted that the "styling" of an engine is done only after the engine layout is complete and the external engine components are added. (Mieritz 106:23-107:14.) Thus, the placement of the external component parts identified in the trademark application

² Honda's functionality expert, James Mieritz, stated that "overall cubic design" refers to the approximately equal width and height of the GX engine when viewed from the perspective shown in the application at issue, as well as the overall visual cubic impression of the engine created by the relative position, shape, size and orientation of the major GX engine components. (Mieritz 102:10-103:20.) Mr. Sugimoto, Honda's Rule 30(b)(6) witness for the redesign of the GX engine, described the GX engine as cubic shaped or squarish. (See Opposer NOR 3-45:15-19; 46:6-9; 46:10-25.) Motohiro Fujita, Honda's corporate representative on the issue of functionality, testified that [REDACTED]

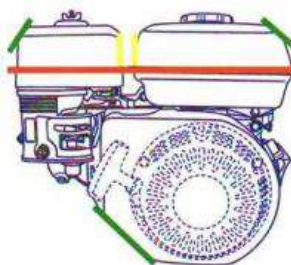
[REDACTED] Steve Conner, Honda's Senior Vice President of the Power Equipment Division, first stated in his deposition that the phrase cubic design in the application simply means [REDACTED] and then changed his testimony at trial to say that [REDACTED]

[REDACTED] (Conner, 12:1-7, 185:12-186:11.) Indeed, Honda concedes that the "shape and position of the component parts" are part of the applied-for mark. (Honda Br. n. 1.)

would necessarily be a part of the functional engineering process, not the later styling of the engine.

2. The Only Features Honda Does Not Admit to Be Functional Are Insufficient to Render the Overall Function Design Non-Functional.

The only features of the “cubic design” Honda’s witnesses do not admit to have functional aspects are the “complementary” angles, lines and bevels Honda now identifies as its “cubic design.” In its brief, Honda’s own depiction of the “complementary beveling and shapes” are very minor flourishes compared to the overall impression of the mark. (Honda Br. 9.) Indeed, Honda submitted the below image to illustrate the “cubic design” of the applied-for mark:³



However, all of the lines – and the combination of the lines – appear to be integrally linked to the overall “boxy” appearance and shape of the engine, which Honda admits is functional. Further, as illustrated below, they are hardly distinctive or unique to Honda:⁴



Generac



Predator



All-Power 208 cc



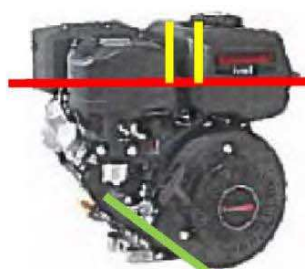
Lifan (EquipSource)



Champion



Briggs 550



Kawasaki



Robin Subaru EX21

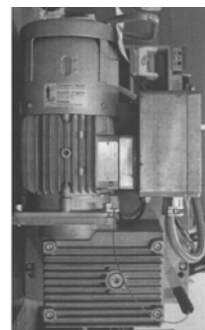
³ Honda admits the left side “slant” to the fan cover is functional for directing cool air from the fan to the hottest part of the engine, but claim that the particular angle is distinctive to Honda. (Mieritz 211:24-212:3.)

⁴ For the Board's convenience, Opposers have submitted more detail on the similarities between Honda's claimed design and the designs currently used in the marketplace as Appendix A.

Finally, to the extent the lines and embellishments could be considered unique or non-functional, they are insignificant when weighed against the overall functional shape of the engine and component parts, and are therefore insufficient to render the overall functional design non-functional. *See In re Becton*, 675 F. 3d at 1374.

3. Courts Have Rejected the Semantic Trickery Honda is Asserting.

Honda's approach in this case is quite similar to the approach taken by Tractel, Inc., a manufacturer of a commercial hoist, which recently attempted to assert trade dress rights against its competitor. *See Secalt, S.A., v. Wuxi Shenxi Constr. Mach. Co.* 668 F.3d 677, U.S.P.Q.2d 1553 (9th Cir. 2012). Tractel claimed that the overall external appearance of its hoist was nonfunctional because the hoist's design demonstrated a "cubist" look and feel. Tractel claimed that the hoist's "cube shape was part of the design look," that the fins shown were "modern" and "flashy," and that its "singular exterior design" set its hoist apart from competitors because it has "more square edges" and a "rectangular look." *Id.* at 683-84. The Ninth Circuit Court of Appeals⁵ flatly rejected this position, and held that Tractel's "fundamental misunderstanding," which infected its entire argument, "is that the presumption of functionality can be overcome on the basis that its product is visually distinguishable from competing products." While such distinctive appearance is necessary, it is not necessarily sufficient to warrant trade dress protection.



A piece of industrial machinery with "rectangular" components that meet each other at "right angles," without more, is wholly insufficient to warrant trade dress protection. It is not enough to say that the design portrays a "cubist" feel – so does a square table supported by four legs. The fins may be attractive but they serve a functional purpose. And the cube-shaped gear box is simply housing. Except for conclusory, self-serving statements, Tractel provides no other evidence of fanciful design or arbitrariness; instead here, "the whole is nothing other than the assemblage of functional parts, and where even the arrangement and combination of the parts is designed to result in superior performance, it is semantic trickery to say that there is still some sort of separate 'overall appearance' which is non-functional."

⁵ While the Ninth Circuit does not use the *Morton-Norwich* factors in making the functionality determination, their analysis is quite similar.

Id. at 684.⁶ Similarly, in this case, Honda argues that the overall external appearance of its engine is nonfunctional because the engine design is “cubic,” “boxy,” “roughly rectangular,” and “the result of many straight lines in each component part.” (Fujita 16:24-17:2.) Honda also claims that this “overall cubic design” sets its engine apart from its competitors and emphasizes the fact that other market participants take measures to differentiate the “look and feel” of their engines.

However, as in *Secalt*, the overall “cubic” look and feel Honda claims is functional. The lines Honda cites may be attractive, but they serve functions, such as sealing component parts (in the case of the rib in the middle of the fuel tank), serving as housing for functional components (in the case of the “cube-like” air cleaner cover), and constitute nothing more than the assemblage of functional parts, which results in a compact and efficient engine.

Similarly, Honda’s entire argument that its applied-for mark is not functional is infected by two fundamental problems. First, as set forth above, Honda has improperly narrowed the characterization of its applied-for mark to very specific lines, angles and features. Second, Honda believes that simply because its engine design may be visually distinguishable from competing products, it is capable of trademark protection. However, Honda cannot rely on these concepts to escape a finding of functionality.

4. Honda’s Fundamental Misapplication of Trade Dress Law Has Infected Its Application of the Four Morton Norwich Factors.

Honda’s improperly narrow characterization of its applied-for mark has infected its analysis of the four *Morton-Norwich* factors.

The Supreme Court has stated that “the disclosure of a feature in the claims of a utility patent constitutes strong evidence of functionality.” *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 31, 58 U.S.P.Q.2d 1001 (2001). Opposers have submitted numerous patents that not only claim or depict all or part of Honda’s applied-for trademark, but also clearly illuminate the purpose for Honda’s overall engine design and certain claimed aspects of the same. The ‘344 and ‘961 Utility Models and the ‘385 Patent claim the overall configuration of the engine with the components located in the same places as the applied-for mark. Indeed, Honda admits that they “describe or claim” the shape and/or placement of the

⁶ The court also affirmed the district court’s finding that the case was “exceptional” and required Tractel to pay the defendants’ attorneys’ fees.

engine's component parts. (Honda Br. 24-25.) The '344 Utility Model specifies that the particular design allows the engines to be "not only compact and lightweight, but also adaptable to a wide variety of applications." The '961 Utility Model explains that having certain component parts in certain locations, namely the controls, improves the functionality of the engine because individual operations may be completed on a single plane. The '160 Utility Model describes a general purpose engine with the same design as the applied for mark, and describes how that design, including the slanted fan cover, allows for cooling of the engine.

Honda argues that the numerous patents identified by Opposers are not applicable because such patents allegedly do not attribute some functional significance to the very specific lines, angles and bevels of the GX engine. (Honda Br. 22.) Apparently, Honda believes that the patents and utility models must claim each and every specific line and bevel of the applied-for mark to be germane to the functionality analysis. This position misses the mark. A patent need not disclose every minor flourish of an applied-for trademark to disclose the functionality of the design or aspects of the design. *See In re Becton*, 675 F. 3d at 1375 ("TrafFix does not require that a patent claim the exact configuration for which trademark protection is sought in order to undermine an applicant's assertion that an applied-for mark is not de jure functional.")

Likewise, when discussing alternate designs,⁷ Honda argues that the engines identified in Opposers' trial brief are in fact, acceptable alternate designs. (Honda Br. 26.) Honda argues that these engines are "visually distinct." This position relies on an improperly narrow characterization of the applied-for mark and results from faulty logic. As set forth above on page 10, many of Honda's so-called alternate designs not only have the same overall configuration and locations of component parts, they share substantially the same lines, bevels, slants and angles that Honda claims to be distinctive.

Not surprisingly, Honda applies the same, narrow characterization of its mark to claim Honda's

⁷ Inexplicably, Honda argues that the Board must consider evidence of alternative designs even if it finds the underlying design to be functional. (Honda Br. 26.) However, every recent Board and Federal Circuit discussing the *Morton-Norwich* factors reiterates that "if functionality is found based on other considerations, there is 'no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available.'" *In re Becton*, 675 F. 3d at 1376 citing *Valu Eng'g. Inc. v. Rexnord Corp.* 278 F.3d 1268, 1276, U.S.P.Q.2d 1422 (Fed. Cir. 2002).

advertisements do not tout any functional benefits. Honda admits that “Honda’s advertising discusses the functional benefits of the GX,” but claims that the advertising does not tout the specific “cubic” look of the trade dress (the same lines, angles and beveling). (Honda Br. 29.) This also misses the mark. Applying the description of the mark included in Honda’s trademark application, Honda very clearly touts the utilitarian advantages of the overall design of its engine, including its compactness and compatibility with a wide variety of OEM power equipment applications, which constitutes strong evidence of functionality. *Kistner*, 97 U.S.P.Q.2d at 1924.

Lastly, Honda argues that it has presented sufficient evidence that its design is not dictated by a comparatively simple or inexpensive method of manufacture. (Honda Br. 29-30). Opposers disagree. The sole evidence in the record on this factor consists of the self-serving, conclusory testimony of Fujita and Mieritz. Further, Honda again argued that only the specific design elements and lines Honda has now used to define its “cubic” mark contribute to this analysis. Given this improper stance and the scarce evidence available, the Board would be justified in refusing to weigh the fourth *Morton-Norwich* factor in this case. *See In re Becton*, 675 F. 3d at 1376. If the Board does consider it, it should note that Honda has cited no authority for the proposition that this factor alone would be sufficient to prove non-functionality.

5. Honda’s Has Not Consistently Defined its Trademark.

Given all of the above, it is not surprising that Honda’s definition of its applied-for mark has been a moving target during prosecution history and this case. Honda has continuously narrowed its characterization of its mark in response to the mounting evidence and testimony which demonstrates that the overall configuration of the engine, the location of the component parts, and various other elements of the engine design are functional. It is also not surprising that Honda’s enforcement efforts of its alleged mark have not been consistent with the position Honda takes in this proceeding. Conner testified that

[REDACTED]

[REDACTED] (Conner 79:3-7; 93:2-6.) He also testified that

[REDACTED]

[REDACTED]

[REDACTED] (*Id.* 92:18-93:1). Notably, however, when walking through examples of

competitive designs and some of the settlements Honda entered, there was no consistent pattern of enforcement or the definition of Honda's "cubic" design. (*Id.* 85:8-102:9). Indeed, Conner admitted that

[REDACTED]

[REDACTED]

[REDACTED] (*Id.* 222:15-223:12). When pressed on how market participants could ever identify the mark given these inconsistencies and ambiguities, Conner simply said that [REDACTED]

[REDACTED]

[REDACTED] (*Id.* 220:9-223:12.). Conner also conceded that [REDACTED]

[REDACTED]

[REDACTED] (*See id.* 264:3-267:4.) Similarly, after comparing various engine designs with the Honda GX engine, Mieritz admitted that, as an expert, he could pick out the design flourishes of Honda's applied-for mark, but "the normal, average person probably might not." (Mieritz 189:7-9.) Indeed, when asked about when an engine would be within the confines of the applied-for mark and when changes to certain components would change the overall cubic appearance, he stated that it would be "in the eye of the beholder" and that it may require a "trained eye" to pick out some of the small changes or differences between engines. (*See id.* 201:22-203:14.) Likewise, Fujita stated that [REDACTED]

[REDACTED] (Fujita 63:24-64:2.)

This testimony from three of Honda's key witnesses illustrates precisely how much "semantic trickery" is in play in Honda's trial brief to remove itself from the definition of the applied-for mark set forth in Honda's trademark application. There is no doubt, however, that despite Honda's arguments, Honda is seeking federal protection for the functional overall engine design identified in its trademark application.

II. THE APPLIED FOR MARK LACKS SECONDARY MEANING

Even if Honda could demonstrate that its engine configuration has a non-functional design (which it cannot), Honda has not and cannot demonstrate that consumers associate the applied-for mark with Honda only. At most, Honda's evidence shows that the GX engine is a successful product and that

consumers associate Honda's distinctive standard three color scheme and famous HONDA trademark with Honda's GX engine. Honda does not dispute that the entirety of its advertising, and the vast majority of its sales, feature the GX in its distinctive standard red, white, and black color scheme as well as the famous HONDA trademark. In addition, Honda's use of the cubic shape and configuration of the GX is far from exclusive. Lastly, Honda's distributor statements and survey evidence are fatally flawed, as they fail to properly focus on the applied-for mark. To the extent Honda now tries to claim that the alleged secondary meaning of the applied-for mark lies in the engine's "complementary lines, angles, and beveling," there is no evidence of consumer association with these elements either, let alone enough evidence sufficient to satisfy Honda's heavy burden.

A. The Length of Honda's Use is Irrelevant Because it is Non-Exclusive.

Honda claims that its sale of the GX engine starting in 1983 is evidence of secondary meaning. However, according to the Board, the "probative value of this factor is greatly diminished" when the use is "not substantially exclusive." *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 U.S.P.Q.2d 1549, 1572-73 (T.T.A.B. 2009). Honda does not dispute that many of its major competitors have long sold engines with the substantially same cubic shape and configuration as the applied-for mark. (Opening Br. at 23-25.) In fact, many of these engines even have the substantially same "complimentary lines, angles, and beveling" as the applied-for mark, such as the engines depicted in Appendix A. Honda also does not dispute the magnitude of these widespread third party uses in the United States market.⁸ This substantial third party use means that consumers are accustomed to seeing similarly shaped and configured engine components in this category, and do not rely on such a common configuration to be source indicator.⁹

⁸ For instance, Subaru has been one of Honda's main competitors in this product category, and has continuously marketed and sold its EX and SP line of horizontal shaft utility engines in the U.S. since beginning in 2001. (Conner 251:5-12; Ex. HH; O3NOR J-3-4; 12) (evaluating the GX against "competitor" engine Subaru Robin EX). In addition, the record shows that Briggs has sold well over [REDACTED] worth of engines with the substantially same cubic shape and configuration as the applied-for mark. (Whitmore 65:6-69:18; Opp. 6-8.)

⁹ Honda has purposefully lessened consumer association of the GX engine with Honda by allowing OEMs to prominently display their trademarks directly on the GX engine. Consumers who see these engines would necessarily either believe they were put out by the OEM or that they were from both the OEM and Honda. As such, this practice will lead consumers to associate the applied-for mark with more than one source. In

Rather than deny that these significant third party uses exist, Honda went to great lengths to have witnesses identify minor differences between the third-party engines and the applied-for mark. Honda's strategy here misses the mark. First, as Honda does not dispute, third party use does not have to be identical to preclude secondary meaning. (Opposer Br. 40.) Second, Honda's argument flies in the face of its position that the large GX (GX240, GX270, GX340) and redesigned midsize GX (GX120, GX160, GX200) have the same commercial impression as the applied-for mark, despite their numerous differences. (Honda Br. 51-54, n. 32; Conner 162:2-164:22; 202:19-212:5.) Third, Honda's position is inconsistent with its strategy to enforce the applied-for mark against engines that are "substantially similar" in appearance, not just identical. (Conner 218:24-220:3.) Thus, Honda's attempt to avoid the significant third party use evidence in the record by identifying minor differences must fail.

B. Honda's Advertising and Sales Merely Show that the GX is Successful.

Opposers do not dispute that the GX engine has been a commercially successful product. This does not, however, demonstrate that consumers view the applied-for mark as a source indicator. As the Board held in *Stuart Spector*, "mere figures demonstrating successful product sales are not probative of purchaser recognition of a configuration as an indication of source." *Stuart Spector Designs, Ltd.*, 94 U.S.P.Q.2d at 1572 ("substantial sales and market share over the years" not enough to establish secondary meaning); *see also In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 U.S.P.Q.2d 1056 (Fed. Cir. 1999) (\$85,000,000 in annual sales revenues and \$2,000,000 in advertising expenditures found insufficient to establish acquired distinctiveness).¹⁰

Further, even if the sales figures were sufficient to establish that there is a singular association

response, Honda notes that these engines still say "Honda," a fact that Opposers do not dispute. Honda also explains the reason why it allows OEMs to place their brands on GX engines. But neither argument addresses Opposers' point that consumers viewing these engines will likely associate the engine's shape and configuration with a source other than just Honda.

¹⁰ Honda mischaracterizes the *George Basch* case, a Second Circuit case finding that there was not an "absence of evidence" to support secondary meaning based on long exclusive use, sales, and advertising, not simply raw sales figures or advertising expenditures as Honda contends on page 36 of its brief. *George Basch Co., Inc. v. Blue Coral, Inc.*, 968 F.2d 1532, 1355 (2d Cir. 1992). Similarly, the *LA Gear* court upheld a secondary meaning finding for which the lower court relied on evidence of copying, sales, advertising, media coverage, and survey evidence, not simply the "sales figures and six months of advertising" Honda misleadingly states on page 32 of its brief. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 12 U.S.P.Q.2d 1001, 1008-1011 (S.D.N.Y. 1989). As such, Honda fails to cite a single case that finds secondary meaning based on sales and advertising alone.

with the appearance of the GX engine, that association would necessarily include association with the engine's distinctive color scheme, not just the applied-for mark. Mr. Connor admitted that [REDACTED] of the sales are in the distinctive red, white, and black color scheme. The next most sold GX engine, roughly [REDACTED] is black. But Honda concedes that the all-black version of the GX is meant for OEMs that sell power equipment with their own color schemes, so that the GX utility engine will blend into the OEM power equipment and are not meant to stand out to consumers. (Conner 124:25-128:12; Opp. 33-35; App. 72.) The remaining small percentage of sales are for engines in just a few specialty colors that Honda uses to specifically match the OEM power equipment color branding scheme. (Conner 128:13-129:15.) Honda's sales figures illustrate the point that Honda and the utility engine marketplace use color schemes, not the shape of engine components, to function as source indicators for consumers. Honda's sales data therefore does not support secondary meaning of the applied-for mark without regard to color.

Likewise, Opposers do not dispute that Honda has spent a significant amount of money to advertise the GX engine. However, Honda concedes that none of its marketing material contains any language that directs the consumer to any aspect of the applied-for mark, let alone any “complimentary lines, angles, and beveling.” As such, Honda's advertisements fail to create an association between the applied-for mark and Honda in the eyes of consumers. Under well-settled Board law, Honda's advertisements therefore do not support secondary meaning.¹¹ (Opening Br. at 40-41; 43.)

At the same time it argues that look-for advertising is not required, Honda claims that somehow its hero shot is “tantamount” to look-for advertising. (Honda Br. at 35.) Honda's position is wholly unsupported by any legal authority and is contradicted by the well-settled law that precludes an applicant from relying on advertisements that simply show the product. *See, e.g., Stuart Spector Designs*, 94 U.S.P.Q.2d at 1572 (“‘Look for’ advertising . . . does not refer to advertising that simply includes a

¹¹ The *Yamaha* and *Black & Decker* cases are distinguishable. In *Yamaha*, the subject design was advertised “not always with the brand name discernible in the advertising copy,” whereas Honda never advertises the GX without the Honda name or distinctive color scheme. *Yamaha Int'l. Corp. v. Hoshino Gakki Co.*, 6 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1988). In *Black & Decker*, the Board found secondary meaning in a key head design despite a lack of look-for advertising where the applicant submitted five trademark registrations of other key head designs showing that it was industry practice to use key head shapes as source identifiers. *In re Black & Decker Corp.*, 81 U.S.P.Q.2d 1841, 1844 (T.T.A.B. 2006). No such evidence is present here.

picture of the product or touts a feature in a non source-identifying manner.”). Honda also does not dispute that it has always used a color hero shot showing the GX engine in its distinctive red, white and black color scheme. And even when Honda uses black and white marketing materials, it shows the Honda GX in its three color scheme, including its signature white fuel tank. Honda offers no evidence that consumers erase the GX’s distinctive color scheme from their minds, leaving only the applied-for mark as a source indicator. In fact, one of Honda’s ads clearly makes the point for Opposers: consumers recall the GX in their minds in red, white and black. (App. 78.) As such, any source indication function that the hero shots create must be with the engine *in color*.¹²

Notably, rather than containing any language directing the consumer to look for any elements of the applied-for mark, Honda’s marketing materials repeatedly direct consumers to look for engines with the *Honda name*. (See, e.g., App. 69) (“trust the engines with the Honda name”). Even the Honda executive responsible for developing, reviewing and approving GX marketing materials testified that he would need to see the HONDA trademark to know whether the engine depicted in the application drawing was a Honda. (O4NOR K-15:1-13; 20:24-22:23.) That candid admission alone should preclude a finding of secondary meaning. And, as discussed in Opposers’ opening brief, Honda’s advertising goals were solely related to touting the engine’s superior functionality. Opening Br. at 25-26.

Regarding Honda’s advertising expenditure evidence, Honda has conceded that it did not know how much of this money was spent on advertisements that actually included images of the engine shown in the trademark application. (Conner 238:22-239:1.) As such, Honda’s evidence regarding advertising expenditures is over inclusive and not very probative on the issue. See *AS Holdings, Inc.* 107 U.S.P.Q.2d at 1838 (advertising expenditures that merely “include” advertisements for applied-for mark “do[] little to help establish that the [applied-for mark] acts as a source identifier in the minds of consumers.”).

C. Honda’s Distributor Statements are Irrelevant to Secondary Meaning.

Honda’s distributor statements suffer from numerous problems that render them irrelevant to the

¹² Indeed, all of Honda’s settlement agreements define the GX Engine Trade Dress via photographs of the engine in the three color scheme. App. 93-103. The only non-color depiction of the GX engine Honda can point to is a single advertisement that was meant to highlight the differences between the Phase II GX and the redesigned GX. (App. 83.)

secondary meaning analysis. First and foremost, the statements show images of both the applied-for mark *and* a photograph of the Honda GX engine showing the HONDA mark and distinctive three color scheme visible in black and white, and the statements reference both the mark and the photograph. Opp. 45 (“[e]ngines having the appearance and shape shown in the attached drawing *and photograph* are known to me as being sold by Honda.”) (emphasis added) Thus, these statements are irrelevant to the question of whether the applied-for mark has achieved secondary meaning. *See In re Florists’ Transworld Delivery, Inc.*, 106 U.S.P.Q.2d 1784, 1793 (T.T.A.B. 2013) (according little weight to customer declarations in part because they did not account for unclaimed subject matter on the images accompanying the declarations). Second, Honda prepared the declarations and none of the distributors made any edits aside from filling in the blanks Honda provided. Conner 157:24-158:2; 158:16-19; 160:3-8. Such declarations are “less persuasive than statements expressed in declarants’ own words.” *In re Pohl-Boskamp GmbH & Co. KG*, 106 U.S.P.Q.2d 1042, 1051 (T.T.A.B. 2013). Third, the declarations suffer from a lack of geographic and marketplace diversity, failing to indicate where the declarants reside and representing a mere subset of GX customers. *Id.* at 1793-94 (criticizing declarations for failing to note where the declarants resided); Mantis 13:1-25 (identifying OEMs, retailers, wholesalers, rental yards, and equipment purchasers as additional classes of GX customers). Finally, the declarations contain conclusory statements that do not specify what is allegedly distinctive about the applied-for mark, and the declarants are all self-interested Honda distributors. Conner 158:3-15; 20-23. These defects render the declarations inadequate on the issue of secondary meaning. *See In re Pacer Technology*, 338 F.3d 1348, 1353 (Fed. Cir. 2003) (Where multiple affidavits are “nearly identical,” “conclusorily worded,” “fail to explain what it is about [the applied-for mark] that is unique or unusual, or distinctive,” and “represent the views of a small segment of the relevant market,” “they are not the kind of ‘competent evidence’ that could carry [Applicant’s] burden of rebutting the PTO’s prima facie case [of non-distinctiveness].”).¹³

D. Honda’s Evidence of Alleged “Copying” Does Not Support Secondary Meaning

¹³ Honda’s awards related to the GX are similarly irrelevant to secondary meaning. Honda admits that the awards were unrelated to the appearance of the engine, but rather given based on “the overall utilitarian operation of the engine and the functionality.” (Conner 232:21-234:5.)

Honda's alleged copying evidence fails to demonstrate secondary meaning because there is no evidence that the third parties offered similarly shaped engines to create confusion as to source. Copying is "only evidence of secondary meaning if the defendant's intent in copying is to confuse consumers and pass off his product as the plaintiff's." *Stuart Spector Designs Ltd.*, 94 U.S.P.Q.2d at 1575; *see also Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 U.S.P.Q.2d 1750, 1766-67 (T.T.A.B. 2013) (rejecting copying evidence due to lack of an intent to cause confusion). There is no evidence that the purported "copies" cited by Honda were produced to confuse consumers.¹⁴ In fact, as the settlement agreements show, these third parties all labeled their engines with their own brand names, indicating that they did *not* desire to trade off Honda's alleged goodwill.¹⁵ *See Stuart Spector Designs Ltd.* at 1575 (noting that alleged copies "clearly display the manufacturer's trademark or trade name on the guitar."); *In re Valkenburgh*, 97 U.S.P.Q.2d 1757, 1768 (T.T.A.B. 2011) (rejecting alleged copying evidence because "the 'copier' has identified its product with a word mark . . . that is different than applicant's . . . word mark."). As such, Honda's alleged copying evidence does not support secondary meaning.

E. The Survey Evidence Strongly Supports The Lack of Secondary Meaning

1. Honda Concedes the Fatal Flaws in Mr. Mantis's Survey.

Honda's half-hearted defense of Mr. Mantis's survey attempts to distract the Board from the survey's fatal flaws. Critically, Honda concedes that Mr. Mantis's test photo shows a GX engine with a three color scheme, including Honda's signature white fuel tank. Honda also does not dispute that consumers associate this color scheme with Honda. Rather, Honda's only justification for Mr. Mantis's admitted use of color in his test photo is to argue that Mr. Poret also performed a color survey. (Honda Br. at 42.) But just two pages later, Honda asserts that Mr. Poret's use of color in his survey "destroys any probative value of the survey." (Honda Br. at 44.) Honda does not explain how Mr. Poret's use of color could "destroy any probative value," while Mr. Mantis's use of color would not do the same.

¹⁴ The evidence strongly suggests that any copying of the GX engine was done for purely functional reasons – i.e., to fit within OEM equipment that was designed around the specifications of the GX. (Conner 72:22-74:2) [REDACTED] (Whitmore 75:22-76:13) (Chinese competitors on the low end of the market sell engines designed to fit within the GX engine's footprint).

¹⁵ This is also true for the engine shown at Opposers' Exhibit 60, for which there is no actual evidence of copying aside from Honda's speculation.

Likewise, Honda does not deny that Mr. Mantis's control photo lacks the same three color scheme as his test photo, and fails to cite any case law supporting Mr. Mantis's improper methodology of controlling for the impact of color through verbatims.¹⁶ Honda also does not deny that using verbatims in this manner ignores the fact that respondents do not always say what they're thinking. And Honda's attempt to explain Mr. Mantis's methodology in controlling via verbatims disregards the fact that there is no way to know whether a "trade dress element" or color actually prompted the Honda response. (Honda Br. at n. 21.) For these reasons, in addition to the other defects in Mr. Mantis's survey that Opposers described in their opening brief, Mr. Mantis's survey should be accorded no weight.

2. Mr. Mantis's Survey Did Not Test for Secondary Meaning in the "Complimentary Lines, Angles, and Beveling"

As discussed, Honda now argues that the "complimentary lines, angles, and beveling" constitute the non-functional features that "create the distinct overall cubic look" of the applied-for mark. This is fatal to Mr. Mantis's survey because Mr. Mantis did not test for secondary meaning in these specific features. First, not a single respondent identified any of these features when they were asked why they believed the test photograph was a Honda. (App. 62.) Instead, the responses were far more general, such as "it looks like a Honda," and Mr. Mantis counted any response that gave any "design or overall appearance-related reason." (App. 62; Mantis 127:24-130:8.) Second, Mr. Mantis failed to weed out association due to the mark's shape and configuration because he used a control engine with a different overall configuration from the applied-for mark. (App. 60; Poret II 33:9-35:24.) As such, Mr. Mantis's survey failed to test for the elements that Honda claims comprise the applied-for mark. *See Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 662-63 (7th Cir. 1995) ("A survey which asks consumers to identify the source of a product based on its overall configuration when most of the product's configuration is functional is worthless in determining whether a particular product feature has acquired secondary meaning.") (*citing Textron, Inc. v. U.S. Intern. Trade Comm'n*, 753 F.2d 1019, 1027 (Fed. Cir. 1985)); *Straumann Co. v. Lifecore Biomedical Inc.*, 278 F. Supp. 2d 130, 137-38 (D. Mass. 2003) (rejecting a survey that failed to show secondary meaning for non-functional features) (*citing Textron*).

¹⁶ Mr. Mantis admitted that he could have controlled for color via a control photograph with the same three color scheme as the test photograph. (Mantis 161:11-162:14.)

3. Honda's Critiques Regarding Mr. Poret's Survey are Immaterial and Inaccurate.

Honda's critiques regarding Mr. Poret's survey are immaterial, and in some instances, simply inaccurate. Honda's first argument that Mr. Poret "did not understand the scope of the applied-for mark" is specious. As Mr. Poret stated, he did not need to know what Honda meant by the language in its application – which Honda's witnesses do not even seem to agree on¹⁷ – in order to perform a proper survey, because he showed the greyscale Honda GX engine photograph to the respondents. (Poret II 74:16-75:5.) Honda cites no authority for the proposition that a survey expert must "understand" what the description of the mark refers to in the drawing for the survey to be valid, and does not explain how Mr. Poret could have even reached such an "understanding" at that stage in the opposition. Honda also fails to present any evidence that Mr. Poret's "understanding" of the mark affected his survey results.

Next, Honda contends that Mr. Poret's color survey is improper because it includes "irrelevant subject matter." This ignores the fact that Mr. Poret's also conducted a non-color survey with greyscale photographs that showed only 19% association, and also ignores Mr. Poret's purpose in performing a color survey: to show the Board the full extent of the impact of Honda's three color scheme on consumer association. (Poret 41:6-42:3.) And of course, if Honda is correct that Mr. Poret's color survey should be disregarded, then Mr. Mantis's survey should also be disregarded. But the reason why Mr. Poret's color survey is probative while Mr. Mantis's is not is that Mr. Poret controlled for color by creating a red, white, and black control photograph, while Mr. Mantis did not. (Opp. 69.) And because Mr. Poret effectively controlled for color, his color survey effectively weeded out responses based on color, thus yielding an accurate 9.7% net association figure for the applied for mark. (Poret II 52:23-54:15.)

Honda's next argument regarding Mr. Poret's use of the Subaru Robin as a control is inconsistent with the vast majority of its trial brief, in which Honda spends considerable time arguing that the Subaru Robin is not substantially similar to the applied-for mark because it does not contain the minor elements that Honda contends creates the allegedly distinct look of the applied-for mark. (Honda Br. at 16, 17, 27, 28, 33, Appendix C.) Likewise, Honda stipulated in a settlement agreement that the Subaru Robin does

¹⁷ See, e.g., Conner 185:17-186:1 [REDACTED]

not embody the applied-for mark. (Conner 248:3-249:3; App. 93.) According to Mr. Poret, this makes the Subaru Robin the perfect control.¹⁸ (O11NOR RR-11, 13 (proper control contains all the elements of the test except for the claimed mark whose influence is being assessed); Poret II 51:7-52:8.)

Honda's additional arguments regarding Mr. Poret's survey are minor and unavailing. Mr. Poret used the same universe as Mr. Mantis, and Honda makes no showing – and indeed does not even claim – that the ratios between segments that Mr. Mantis used were in any way superior to Mr. Poret's ratios, let alone that the differences in ratios had any material effect on Mr. Poret's survey. (Poret II 45:1-46:23.) Honda's next criticism regarding Mr. Poret's characterization of the Subaru Robin as an overhead valve engine is backwards. Once Mr. Poret identified the Honda GX as an overhead valve engine, he was obligated to do the same for the Subaru Robin. (Poret II 46:24-49:10.) And, to the extent that respondents were able to identify the Subaru as an overhead cam engine, it would *reduce* the likelihood that such respondents would identify the engine as a Honda, thus *increasing* the net association number. *Id.* Honda does not point to any verbatim responses indicating that this instruction biased any of the answers. (Mantis 173:18-174:7.) Likewise, Honda cites no evidence that Mr. Poret's decision not to rotate his answer choices affected his survey results, and in fact Mr. Poret did control for order bias by presenting the questions in the same order for the test and control subjects. (Mantis 176:3-177:15; Poret II 49:11-51:6.) Mr. Poret has constructed many surveys in this manner, and has never been criticized on this basis. (Poret II 50:2-7.) Finally, Honda offers no evidence that Mr. Poret's interviewers failed to properly record responses, and Mr. Poret was not obligated to independently validate his survey results because he used a professional telephone interviewing service he's used many other times whose calls were being monitored by the interview company, Mr. Poret's staff, and Mr. Poret himself. (Poret II 55:17-59:19.)

In sum, Honda's critiques of Mr. Poret's survey are immaterial, inaccurate, and meant to distract the Board from Mr. Mantis's survey which, in Honda's own words, "lacks probative value."

III. THE APPLIED-FOR MARK IS GENERIC

¹⁸ This is another example of Honda trying to have it both ways, arguing on one hand that the Subaru Robin has a "distinct" overall look from the applied-for mark (Honda Br. at 33), while on the other hand it is too similar to the applied-for mark to act as an adequate control.

As discussed in Opposers' opening brief, the applied-for mark has become the industry standard shape and configuration through widespread use by many of Honda's major competitors. Honda has failed to enforce its alleged trade dress rights against any of these third parties, even expressly allowing them to market and sell these engines, and the applied-for mark is therefore generic.¹⁹

IV. HONDA HAS ABANDONED THE APPLIED-FOR MARK

Honda does not dispute that it redesigned the appearance of the GX engine, and that it permanently ceased importing and manufacturing for use in the U.S. the prior engine design ("Phase II"). Honda also does not dispute that it created new marketing materials for the redesigned engine, and destroyed the old marketing materials. Instead, Honda hangs its hat on the Phase II engines it claims remain in inventory. (Honda Br. at 51.) But Honda glosses over three important distinctions. First, the applied-for mark shows the midsize GX engines, not the large GX engines like the GX 390 and GX390RT1 Honda references in footnote 32. Second, only ■■■ midsize GX engines are currently left in inventory, and these engines have sat on the shelves since 2012. (Opp. 50-53; Conner 171:11-176:24.) Third, these ■■■ engines do not embody the applied-for mark because they have cyclone-style air cleaners. (Opening Br. at 28.) Even if these engines embodied the applied-for mark, this would be an insufficient amount to constitute "use" for purposes of abandonment. *See Nabisco Inc. v. Wm. Wrigley Jr. Co.*, 40 U.S.P.Q.2d 1251, 1257-58 (T.T.A.B. 1995) (sale of 340 products bearing mark was "insufficient to contravene or rebut [] prima facie showing of abandonment...").

Honda attempts to get around its own non-use of the applied-for mark by attempting to rely on use by its distributors and dealers. But, even if Honda's distributors and dealers were in fact still selling the Phase II GX engine – and Honda provides no evidence showing this other than speculation by its witness – it would not be enough to prove use by *Honda* sufficient to rebut Opposers' prima facie showing. *See Parfums Nautee Ltd. v. Am. Int'l. Indus.*, 22 U.S.P.Q.2d 1306, 1309 (T.T.A.B. 1992) ("A party cannot defend against a claim of abandonment by relying on some residual goodwill generated through post-abandonment sales of the product by distributors or retailers.").

¹⁹ Honda's argument that the approved Lifan engine shown on p. 51 of Opposers' opening brief "differs significantly" from the applied-for mark demonstrates the lengths Honda will go to avoid a finding of genericness.

Honda also does not deny that it is currently illegal to import or manufacture for sale in the U.S. the Phase II GX, that it is unaware of any documents discussing the possibility of using the Phase II engine in the future, that there is no project team currently working on the Phase II design, that Honda took all new photography for its marketing materials, that Honda destroyed all marketing materials showing the Phase II design, and that Honda does not have any plans to advertise the Phase II design in the future, let alone present any evidence showing that Honda intends to resume use of the applied-for mark. (Opening Br. at 27, 55.) As such, Opposers have satisfied their burden to prove that Honda does not intend to resume use of the applied-for mark.

Finally, Honda does not deny that the redesigned GX eliminated virtually all of the elements Honda argued to the Examiner were distinctive, such as ribs on the carburetor cover,²⁰ “belt” on the air cleaner cover, and beveled top edges, giving the redesigned GX, in Honda’s own words, [REDACTED] [REDACTED] (O3NOR J-3-4.) Indeed, in addition to the shape and configuration of the engine, these were the *only* elements Honda listed in its March 4, 2009 response to office action as being allegedly non-functional. Honda also ignores the fact that one of the main elements it identifies in its trial brief as contributing to the distinctiveness of the applied-for mark – “complimentary angles of its bevels” – is not present in the redesigned GX. If these elements are, as Honda claims, distinctive, then Honda’s removal of these elements must have changed the commercial impression of the GX engine. *See In re CTB, Inc.*, 52 U.S.P.Q.2d 1471, 1476 (T.T.A.B. 1999) (deletion of “distinctive subject matter” constituted a material alteration of the mark).

CONCLUSION

For all the foregoing reasons, Opposers' opposition should be sustained.

²⁰ Honda’s refusal in its trial brief to even mention the ribs on the carburetor cover, let alone acknowledge their distinctiveness, perfectly illustrates Honda’s opposition-driven approach to interpreting the applied-for mark. Honda has repeatedly stressed the distinctiveness of this element since prosecution of the applied-for mark. For example, in its March 4, 2009 response to office action, Honda argued and its two functionality experts opined that the ribs were “ornamental and arbitrary.” Likewise, Honda’s trial witness Mr. Conner described the ribs as [REDACTED] and Honda’s functionality expert Mr. Mantis testified that the ribs were “distinctive stylistic features of the GX engine.” (Conner 211:5-16; Mieritz 191:21-192:6.) Of course, because Honda removed the ribs when it redesigned the GX engine, it has now changed course and is attempting to minimize the commercial effect of the ribs to avoid a finding of abandonment.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing OPPOSERS BRIGGS & STRATTON CORPORATION'S AND KOHLER CO.'S REPLY TRIAL BRIEF has been served on the following counsel of record by depositing same in the U.S. Mail, first class postage prepaid this 28th day of January, 2016:

Sarah Frazier
Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, MA 02109-1800
Telephone (617) 526-6448
Facsimile: (617) 526-5000
Email: michael.bevilacqua@wilmerhale.com;
barbara.barakat@wilmerhale.com;
vinita.ferrera@wilmerhale.com;
john.regan@wilmerhale.com;
sarah.frazier@wilmerhale.com;
shira.hoffman@wilmerhale.com;
silena.paik@wilmerhale.com

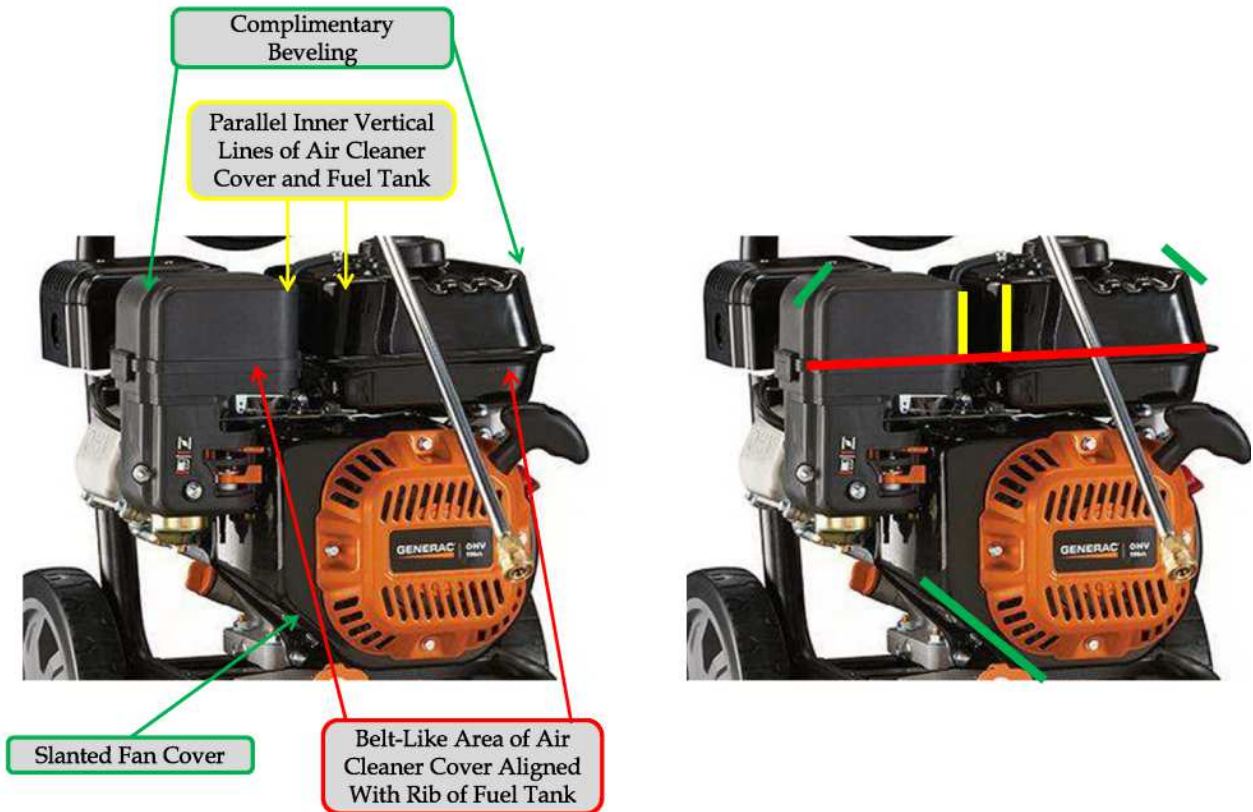
Kenneth R. Nowakowski
Melinda S. Giftos
Whyte Hirschboeck Dudek S.C.
555 E. Wells Street, Suite 1900
Milwaukee, Wisconsin 53202
Telephone: (414) 273-2100
Facsimile: (414) 223-5000
Email: knowakowski@whdlaw.com
mgiftos@whdlaw.com

/s/ Deborah Kalahale
Deborah Kalahale

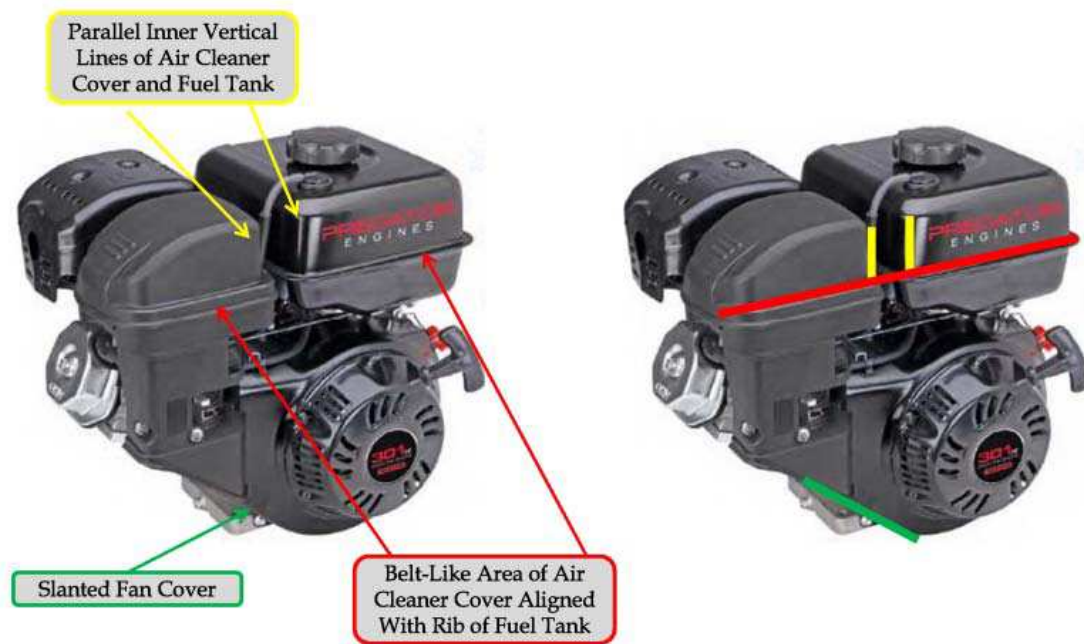
APPENDIX A

THIRD-PARTY ENGINES WITH SAME COMPLEMENTARY ELEMENTS HIGHLIGHTED BY HONDA IN ITS TRIAL BRIEF

Generac



Predator



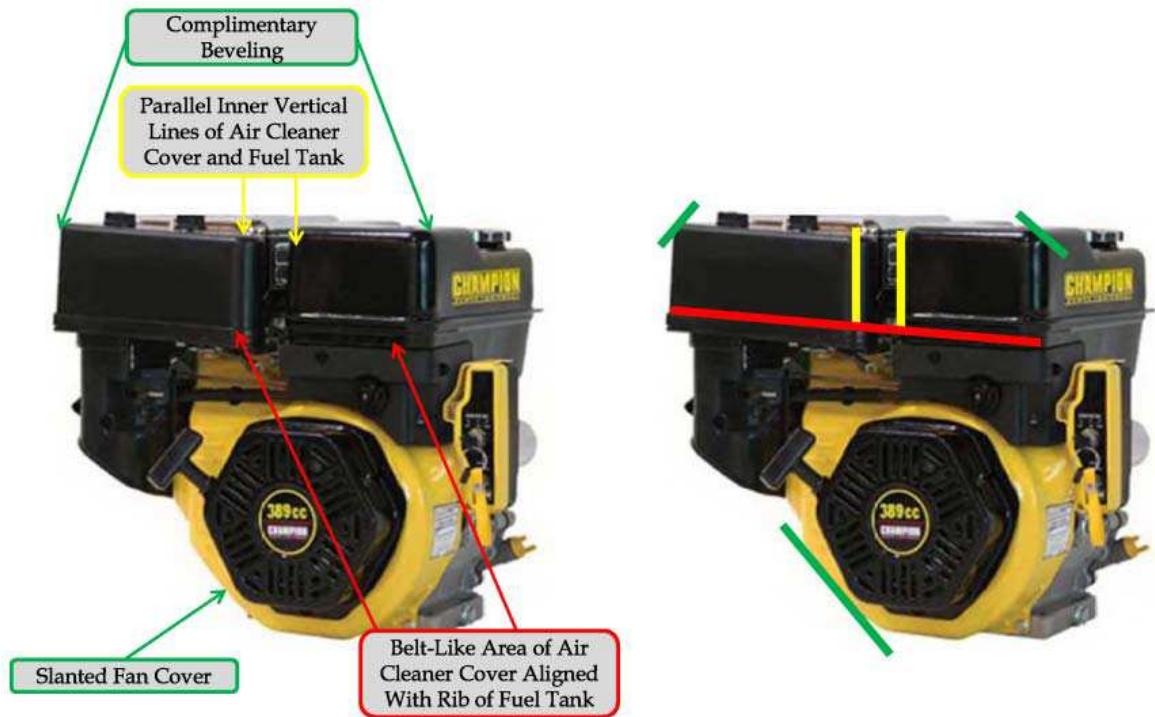
All-Power 208 cc



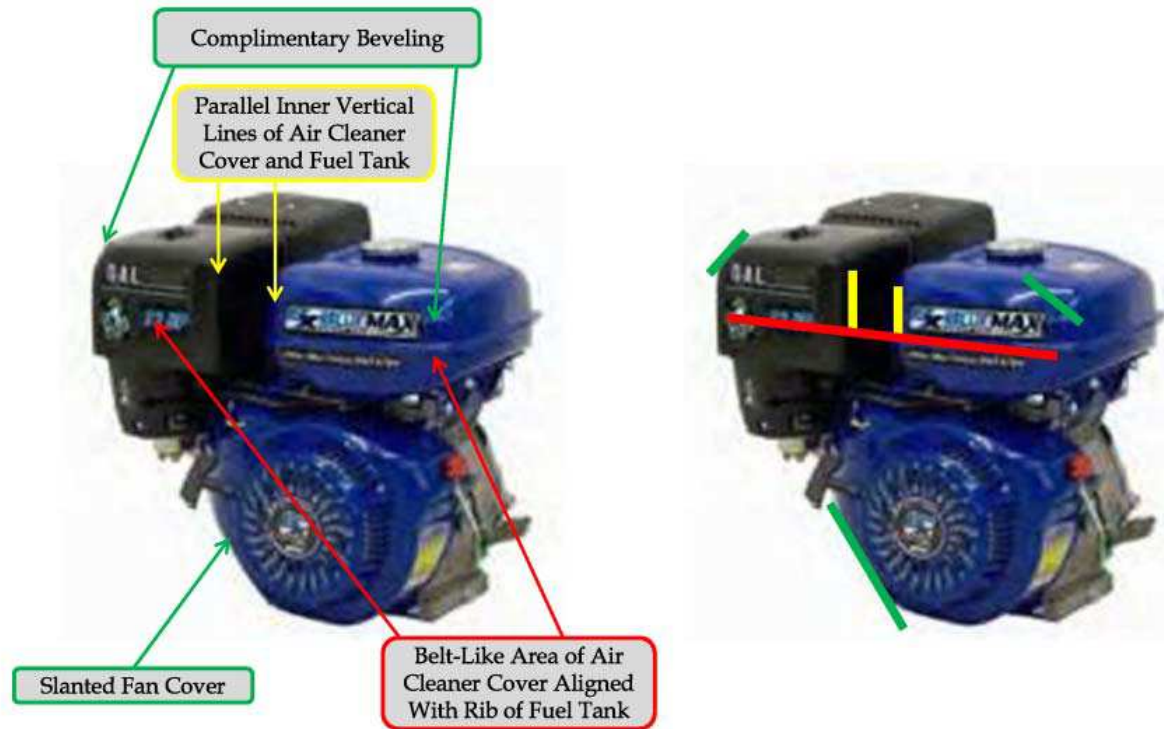
Lifan (EquipSource)



Champion



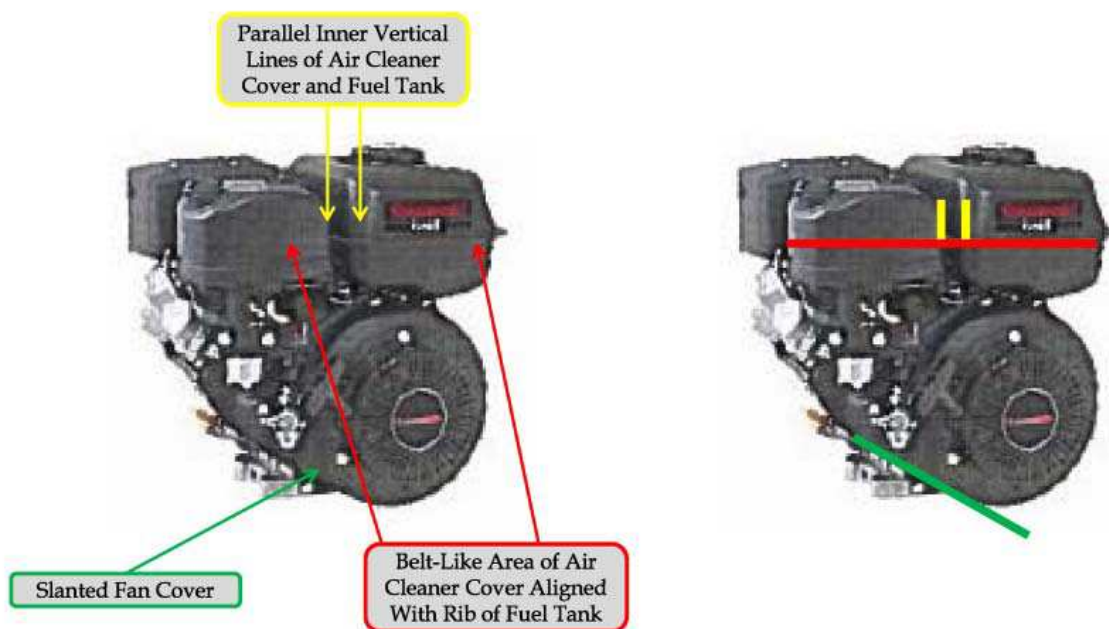
Blue Max



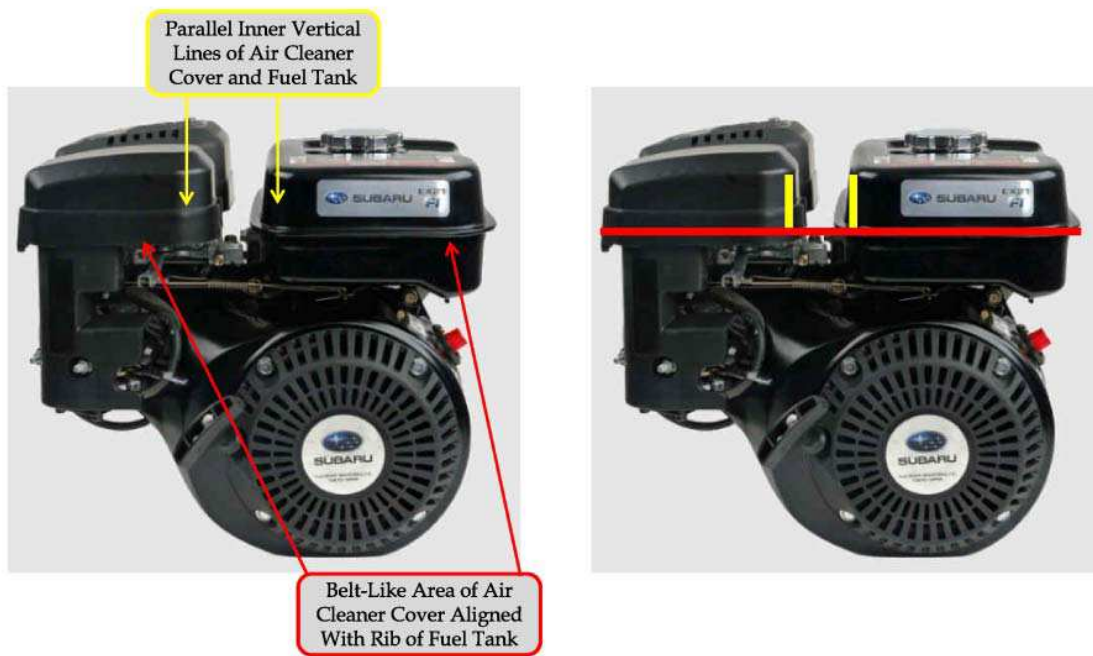
Briggs 550



Kawasaki



Robin Subaru EX21



APPENDIX B – OPPOSERS’ RESPONSE TO HONDA’S EVIDENTIARY OBJECTIONS

I. Testimony of Professor John Reisel.

Contrary to Honda's objections, Professor John Reisel is more than qualified to provide the opinions he has in this case. Dr. Reisel is a mechanical engineer with extensive experience with engines that qualifies him as an expert permitted to provide opinion testimony about the mechanics of engines. Honda's motion to strike his testimony should therefore be denied.

A. **Dr. Reisel is Qualified to Provide the Expert Testimony Given.**

Dr. Reisel is qualified to opine on the functionality of engines. An expert's opinion testimony is admissible if: (1) the expert is qualified by knowledge, skill, experience, training, or education on the subject matter of the testimony; (2) the testimony is reliable—based on sufficient facts or data, and the product of reliable principles and methods that are reliably applied to the facts of the case; and (3) the testimony is relevant—will assist the trier of fact. *See Daubert v. Merrill Dow Pharm., Inc.*, 509 U.S. 579, 27 U.S.P.Q.2d 1200, 1204-05 (1993); *see also* Fed. R. Evid. 702.

By the very terms of Rule 702, education or experience related to the subject matter of the testimony can provide qualifications to opine on that subject matter. Fed. R. Evid. 702, *see also Roman v. Western Mfg., Inc.*, 691 F.3d 686, 692-93 (5th Cir. 2012) (finding individuals to be qualified as experts because they each held Ph.Ds in their respective fields of mechanical engineering and material science, and therefore had specialized "knowledge, skill, experience, training or education," even if they lacked specific industry experience). Through his education and professional experiences, Dr. Reisel has developed specialized knowledge that makes him qualified to opine on the functionality of components of the GX engine. Dr. Reisel has a PhD in mechanical engineering, or the design, analysis and manufacturing of devices that include moving parts. His specific qualifications include: (1) nine years of post-high school mechanical engineering education; (2) a professional engineer license; (3) twenty-one years of experience teaching mechanical engineering courses, including teaching an advanced course on engines fourteen times; (4) experience conducting and supervising research on engines; (5) experience as the associate director for the Center For Alternative Fuels, focusing primarily on small engines; and (6) experience working with the Wisconsin Small Engine Consortium. He has refined his understanding of

general mechanical engineering principles like heat transfer, thermal dynamics, fluid mechanics, machine and component design, material science, and engineering economics, and how they apply to engines. Specifically, Dr. Reisel has applied the general mechanical engineering principles to small engines, including vertical shaft engines. Dr. Reisel also spent considerable time with Kohler and Briggs & Stratton engineers to familiarize himself with the particular engines at issue in this case. (See Reisel 6:24-8:11, 9:10-24, 12:16-35:24.)

Dr. Reisel's testimony falls squarely within the subject matter of his expertise: small engines. Dr. Reisel offered opinions on a multitude of functional aspects of an engine, which ultimately affects the external appearance of the engine. (Reisel 26:5-62:8.) His opinions related to features like the overall compact design, the slated fan cover, the positioning, shape, and beveling of the fuel tank, the position and shape of the air cleaner, and placement of the control levers. (*Id.*) Dr. Reisel's mechanical engineering experience with engines qualifies him to opine on these functional components of the engine, which ultimately informs the external appearance of the engine. *See Daubert*, 509 U.S. 579.

B. Honda's Motion is Without Merit

Honda's argument that Dr. Reisel is unqualified to offer his opinion testimony (1) rests on a mischaracterization of the subject matter of his opinions, and (2) improperly narrows the scope of his experience, missing the mark on what is necessary to qualify as an expert. Throughout its argument, Honda characterizes Dr. Reisel's testimony to pertain to the "external appearance" of an engine. (Honda Br. A-9-A14.) In doing so, Honda completely misses the point. As demonstrated above, Dr. Reisel has offered opinions on the functionality of various components of the engine, each of which affect the external appearance of the engine. Despite Honda's interpretation, Dr. Reisel's testimony is not limited to (nor should it be limited to) the external appearance of the engine. Dr. Reisel's testimony on functionality falls squarely within his experience with engines.

Honda also attempts to undercut Dr. Reisel's qualifications by arguing that he has not worked with either the precise engine at issue or the exact type of engine, and claim his pollution focus somehow eliminates his qualifications to opine on more basic functionality. (Honda Br. A-11-13.) However, Dr. Reisel's experience need not be the precise issue before the court to be admissible—*i.e.* horizontal shaft

engines—so long as the fit between his qualifications and the proffered opinions render the opinions sufficiently reliable.²¹ See *Roman*, 691 F.3d at 692-93 (witnesses qualified to testify about the failure of a stucco application pump despite neither expert having experience in the stucco industry, where one worked with a similarly designed product and had a Ph.D. in mechanical engineering and the other had experience with malfunctioning machinery and a Ph.D. in material science). The engineering principles apply equally to vertical and horizontal shaft engines, and thus Dr. Reisel’s experience has a sufficient fit with the issue here. (Reisel 20:4-21.) Further, Dr. Reisel spent considerable time in this case examining the engines at issue. (Reisel 23:24-25:24.)

Finally, Honda’s critiques of Dr. Reisel on the grounds that his expertise in mechanical engineering is not sufficient to provide expert opinions on the alleged non-functionality in this case is directly belied by the fact that Honda has relied on an individual with similar credentials to provide opinions on functionality Honda’s applied-for mark and alleged GX trade dress. Specifically, during its trademark prosecution, Honda submitted the Declaration of Kevin Hoag, in support of its argument that the applied-for mark is non-functional. (Office Action Response 3/4/2009, Declaration of Kevin Hoag.) Honda also retained Mr. Hoag to provide expert opinions on these technical issues in Honda’s litigation against The Pep Boys in 2007. (See O8NOR.) Mr. Hoag’s qualifications are very similar to those of Dr. Reisel’s, although Mr. Hoag does not even have a PhD. He is professor, educated in mechanical engineering, however, and has been relied on extensively by Honda with respect to its applied-for mark and alleged GX trade dress rights. (See Office Action Response 3/4/2009, Declaration of Kevin Hoag.)

²¹ None of the four cases Honda relies upon compel its conclusion on Dr. Reisel’s qualifications. For example, in *Ancho v. Pentek Corp.*, the appellate court upheld a finding by the trial court that a mechanical engineering degree alone did not qualify the witness to testify about redesigning a manufacturing plant. 157 F.3d 512, 518 (7th Cir. 1998). In *Ralston v. Smith & Nephew Richards, Inc.*, the appellate court affirmed a decision by the trial court to exclude testimony by a board certified orthopedic surgeon with an expertise in oncology on the adequacy of the product warnings for a surgical device used on a former cancer patient. 275 F.3d 965, 969-70 (10th Cir. 2001). The witness had admitted she knew nothing about the device, nor drafting surgical techniques or product warnings, and thus her opinions on the warnings fell outside her expertise of general surgical principles. *Id.* In *Shreve v. Sears, Roebuck & Co.*, the district court excluded testimony of a mechanical engineer who had no experience with snow throwers, the product at issue in the case, except an hour and a half that he spent with the product during summer conditions. 166 F. Supp. 378, 392-93 (D. Md. 2001). Finally, in *Poosh v. Philip Morris USA, Inc.*, the court found “an epidemiologist with expertise in health behavior and the use of cigarettes” was unqualified to opine on cigarette design. 904 F. Supp. 2d 1009, 1019 (N.D. Cal. 2012). In each case, the qualifications and proffered opinion lacked the fit necessary to render the opinions reliable under federal law.

Conclusion

Dr. Reisel possesses specialized knowledge, skill, experience, training, and education related to small engines that qualify him as an expert to opine on the functionality of the challenged components of the GX engine at issue. Accordingly, the Board should deny Honda's request to strike his testimony.

II. Documents from Foreign Trademark Proceedings

Contrary to Honda's mischaracterization, Opposers do not rely on the objected-to foreign trademark documents for any legal conclusions or application of "foreign trademark standards." Rather, Opposers rely on observations and admissions contained in these documents that are not specific to any foreign laws or markets.²² Honda's objection should therefore be denied.

Honda objects to two documents submitted by Opposers. The first is an OHIM opinion regarding a trade dress application for the GX engine. Opposers do not rely on OHIM's ultimate conclusion. Rather, Opposers submitted the OHIM decision for the tribunal's observation that the vertical and horizontal planes of the GX engine are "in line" in order to create a more compact engine. (O1NOR E-21, para. 19.) This observation is relevant to the issue of functionality, and Opposers do not rely on any legal conclusions the tribunal may have drawn from it. This document therefore does not fall under any of the authority Honda cites, and Honda's objection to it is meritless.

The second foreign trademark document on which Opposers rely is a submission by Honda to the Istanbul Commercial Court. This filing is relevant because it reflects Honda's views that the GX engine is "renowned . . . for occupying little space" and that the red, white, and black color combination is the "most important feature" of the GX engine trade dress. (O1NOR E-66-67.) These statements were made by Honda's agents in the context of the "world market," and there is no indication they were limited to Turkey as Honda claims in its objection. (*Id.* at E-66, paras. 4, 5; 67, para. 7; 70, para. 9) ("The **shape and colour composition** of the 'GX Series' General Purpose Engines . . . **became known by everybody and further reached an eminent distinguishability by its quality** as a result of not only their sales all through the world **starting from the beginning of the 1980s** through Our Client's wide distribution

²² This is in contrast to Honda's Exhibit I, which Honda submits solely to show, without any context or discussion, that a foreign trademark tribunal allowed what appears to be a six-sided trademark showing the GX engine to register.

network of which we attached a list, but also through the advertisements and promotions that is given by the client for years in **all over the world** and in Turkey.”) (emphasis in original, final emphasis added). Indeed, Honda’s acknowledgement that the red, white, and black color combination is the “most important feature” of the GX engine trade dress was not specific to the Turkish market or Turkish law, but rather stated as a background fact regarding the engine in general. *Id.* at E-67, para. 7. It is therefore admissible as an admission by Honda.

In sum, because Opposers do not rely on the application of any foreign trademark standards or the decisions of any foreign trademark tribunals contained in the two objected-to documents, Honda’s objection should be denied.

III. Japanese Utility Models.

Honda seeks to strike Opposers’ Exhibits T-GG, which contain Japanese utility model evidence, on the grounds that only United States utility patent and utility patent applications should be considered by the Board under the *Morton-Norwich* analysis. However, Honda has not cited to any precedent from the Board or the Federal Circuit for the proposition that only U.S. patents are relevant to the determination of whether an applied-for product configuration is functional.²³ All of the Japanese utility patent-type documentation provided in Exhibits T-GG--including both the utility model application documentation and the utility patent application documentation--should be considered as relevant to determining functionality because the evidence fits squarely within the analysis of *TrafFix Devices, Inc. v. Mktg. Displays, Inc.* 532 U.S. 23, 29-30, 58 U.S.P.Q.2d 1001 (2001) and progeny such as *Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1273-74,(61 U.S.P.Q.2d 1422 (Fed. Cir. 2002)).²⁴

²³ Although Honda points to *Franek v. Walmart Stores, Inc.* No. 08-CV-0058, 2009 WL 674269 (N.D. ILL. March 13, 2009) aff’d 615 F.3d 855 (7th Cir. 2010) in support of the contention that foreign patent documents are not relevant, in that case the Northern District Court of Illinois merely stated in a single footnote that it “would be reluctant to extend *TrafFix* to the consideration of foreign patents without any supporting precedent.” *Id.* at * 14 n.11. One district court’s being “reluctant” to consider foreign patents does *not* at all constitute any decision, much less any decision by the Federal Circuit or the U.S. Supreme Court, that foreign patent documents or any other foreign patent-type documentation are irrelevant to determining functionality.

²⁴ Consistent with this view, the Northern District Court of California has considered foreign patents in its functionality analysis. *Alphaville Design, Inc. v. Knoll, Inc.* 627 F. Supp. 2d 1121, 1131 (N.D. Cal. 2009).

Indeed, both granted utility models and utility model applications are of great importance. The Supreme Court and Federal Circuit appear to agree and have explained: “[w]e agree with the Board that an abandoned patent application should be considered under the first *Morton-Norwich* factor, because an applied-for utility patent that never issued has evidentiary significance for the statements and claims made in the patent application concerning the utilitarian advantages, just as an issued patent has evidentiary significance” *Valu Eng’g*, 278 F.3d at 1279, and “statements made in the patent applications and in the course of procuring the patents demonstrate the functionality of the design.” *Traffix*, 532 U.S. at 32. These statements contain no limitation that patents and applications outside the United States have less impact or meaning in the functionality analysis.

To the contrary, consideration of foreign utility patent-type documentation is consistent with the public policy concerns underlying these decisions. Statements contained in patent-type documentation are relevant and should be considered simply because the statements are ones “concerning the utilitarian advantages.”

Rule 401 of the Federal Rules of Evidence broadly defines relevant evidence as evidence having “any tendency to make a fact more or less probable than it would be without the evidence” where “the fact is of consequence in determining [an] action.” From even the most cursory review of the proffered Japanese utility patent-type documentation, it is apparent that this documentation discloses functional features and characteristics of internal combustion engines that are identical or similar to those to which the GX Trade Dress pertains, and therefore bears upon the issue of functionality.

Even more importantly, all of the proffered Japanese utility patent-type documentation of Exhibits T-GG concerns utility model applications and utility patent applications pursued by Honda. Consequently, the statements and disclosures provided in Exhibits T-GG should be considered admissions by Honda regarding the functional features and characteristics of its engine design.

Finally, it is important to note that the Japanese patent system is highly similar to the patent systems of the United States, and that Japanese utility models are very similar in their nature to standard utility patents. *See, generally*, Brian G. Strawn, *Guide to Japanese Intellectual Property Law*, 26 AIPLA Q.J. 55 (1998). Japan’s utility model system conceptually constitutes a “second tier patent system,”

which is a patent system that complements another patent system “to offer a more accessible form of patent protection for a shorter term, usually characterized by less stringent patentability requirements.”

Peter A. Cummings, *From Germany to Australia: Opportunity for A Second Tier Patent System in the United States*, 18 Mich. St. J. Int’l L. 297, 300 (2010). As stated by one commentator, in Japan,

“[t]he Utility Model Act permits registration of inventions that fulfill the requirements of novelty and utility, and meet a lower standard of inventiveness, satisfied ‘when a device is such that it could have quite easily been made by a person having ordinary knowledge in the technical field to which such device pertains.’”

H. Stephen Harris, Jr., *Competition Law and Patent Protections in Japan: A Half-Century of Progress, a New Millennium of Challenges*, Colum. J. of Asian L. 71, 78 (2002) (footnote omitted).

Although Honda implies that something about the Japanese utility model system “in place at the time of these applications (the 1980’s)” might somehow undermine the relevance of that Japanese utility model documentation, if anything the system in place at that time bore even greater similarity to the U.S. patent system than the Japanese utility model system in place today does. Indeed, although there currently no longer remains any requirement that Japanese utility model applications be substantively examined, prior to 1994 “Japan registered a utility model by not only examining it for compliance with formalities, but also required that the applicant or a third party request that a substantive examination be made within four years, otherwise the application would be considered withdrawn[, where t]his substantive examination was similar to patents, and gave applicants confidence in the validity of their utility models.” See Cummings at p. 307 (footnote omitted).

Because the Japanese utility model documentation is highly relevant to the issues before the Board, the Board should deny Honda’s request to strike them from the record.